

### **III. REMARKS/ARGUMENTS**

#### **A. Status of the Claims**

Claims 11-35 are pending. Claims 1-10 have been cancelled, without prejudice. Claims 12, 13, 17, 18, 20-26, 32 and 34 are withdrawn from consideration. Claims 11, 14-16, 19, 27-31, 33 and 35 stand rejected. Applicants have amended claims 11, 15, 27, 30, 28, 31 and 35. No new matter is introduced by these amendments, and these amendments are fully supported by the specification. Applicants respectfully request reconsideration of the rejections of these claims for at least the following reasons.

#### **B. Allowable Subject Matter**

Applicants express their appreciation for the indication that claims 15, 16, 30, and 35 would be allowable if rewritten to overcome the alleged rejections under 35 U.S.C. § 112 and if rewritten in independent form. In view of these amendments, Applicants submit that these claims are in condition for allowance.

#### **C. Claim Rejections Under 35 U.S.C. § 112**

Claims 11, 14-16, 19, 27-31, 33 and 35 stand rejected under 35 U.S.C. § 112, ¶ 2 as allegedly indefinite. Specifically, with regard to claims 11, 27 and 28, the Office Action alleges that there is insufficient antecedent basis for elements in these claims. Accordingly, Applicants have amended these claims.

#### **D. Claim Rejections Under 35 U.S.C. § 102(b)**

Claims 11, 14, 19, 27-29, 31 and 33 stand rejected under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent No. 3,846,958 to Divan. Specifically, with regard to claims 11, 14 and 19, the Office Action asserts:

In regards to claim 11, Divan discloses the same invention including a blade assembly for slicing thin section from a work piece (26), a plurality of transfer rollers sequentially arranged in tangential proximity to each other (40 and 58 the conveyor belt rolls and is therefore a roller), a thin section in contact with the surface of one transfer roller will be transferred to the surface of the sequentially successive transfer roller (Column 3 lines 20-40), a first sequential transfer roller is oriented in proximity to the blade assembly (40) so that a thin section sliced from the work piece will contact the surface of the first sequential transfer roller (Column 3 lines 20-40), and a receiving medium (39) disposed in tangential proximity to a final sequential transfer roller (58) so that the thin section on the surface of the final sequential roller will be transferred to the receiving medium in a substantially smooth and flat configuration (Fig. 1).

In regards to claim 14, Divan discloses at least a portion of a circumference of one of the transfer roller is temperature controlled (the room is at a certain controlled temperature and therefore the roller would adopt the properties of this surrounding temperature).

In regards to claim 19, Divan discloses display means (48).

Office Action, Page 3. Applicants respectfully disagree.

In order for a claim to be anticipated by a reference, that reference must disclose each and every element of the claimed invention. *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987) (“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.”); *see also Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989) (“The identical invention must be shown in as complete detail as is contained in the . . . claim.”). Independent claim 11 recites:

An apparatus for applying thin sections of a tissue sample to a receiving medium comprising:

a blade assembly for slicing a histologic-grade slice from a tissue sample;

a plurality of transfer rollers sequentially arranged in tangential proximity to each other, such that said histologic-grade slice in contact with a surface of one transfer roller will be transferred to the surface of the sequentially successive transfer roller;

wherein a first sequential transfer roller of said plurality of transfer rollers is oriented in proximity to said blade assembly so that said histologic-grade slice sliced from said tissue sample will contact the surface of said first sequential transfer roller; and

a receiving medium disposed in tangential proximity to a final sequential transfer roller of said plurality of transfer rollers so that said histologic-grade slice on the surface of said final sequential transfer roller will be transferred to said receiving medium in a substantially smooth and flat configuration.

Appl'n, Claim 11 (emphasis added). Clearly, this claim is directed to the preparation of histologic-grade slices from tissues samples.

Divan, on the other hand, discloses an apparatus for slicing bacon and for the arrangement of the bacon in a shingled form with controlled weight. Divan, Col. 1, ll. 6-8. Bacon is not, however, a "thin section" that is to be put on slide for use in, for example, a microscope system. In addition, the bacon's "shingled form" is not a "substantially smooth and flat configuration" as recited in claim 11. Simply put, a bacon slicing apparatus is not the "same invention" as Applicants have claimed.

Nevertheless, although Applicants do not agree with the Office Action, in an effort to expedite the prosecution of this application, Applicants have amended independent claim 11 to specify that the "thin section" is a "histologic-grade slice." Therefore, as there can be no question that a bacon slice is not a "histologic grade

slice,” Applicants respectfully request allowance of independent claim 11 and all claims dependent thereon.

With regard to claims 27-29, 31 and 33, the Office Action asserts:

In regards to claim 27, Divan discloses the same invention including a holding assembly for manipulating a work piece (20), a blade assembly for preparing a thin section from the work piece (28 and 26, See 112 rejection above), a transfer roller mechanism (40 and 58) for transferring the thin section in contact with the surface of a transfer roller to a receiving medium (39), and a controller (31).

In regards to claim 28, Divan discloses the blade assembly further comprises a preliminary blade for removing slices from the work piece to a desired depth prior to the preparation of work piece (22).[.]

In regards to claim 29, Divan discloses the controller tracks the work piece (31).

In regards to claim 31, Divan discloses a first transfer roller positioned adjacent to the blade assembly for receiving the thin section from the blade (40) and a second transfer roller (58) for receiving the thin section from the first transfer roller and transferring the thin section to the receiving medium (39).

In regards to claim 33, Divan discloses at least a portion of a circumference of one of the transfer roller is temperature controlled (the room is at a certain controlled temperature and therefore the roller would adopt the properties of this surrounding temperature)

Office Action, Page 4. Applicants respectfully disagree.

Similar to independent claim 11, independent claim 27 also recites “a blade assembly for slicing a histologic-grade slice from said sample block.” As discussed above, Divan does not disclose this element as it does not cut a histologic-grade slice. Therefore, Applicants respectfully request that the rejection of independent claim 27, and all claims dependent thereon, be withdrawn.

#### IV. CONCLUSION

Applicants respectfully submit that the application is in condition for allowance. Applicants believe that no fees are necessary in connection with the filing of this document. In the event any fees are necessary, please charge such fees, including fees for any extensions of time, to the undersigned's Deposit Account No. 50-0206. Should any outstanding issues remain, the Examiner is invited to telephone the undersigned at the number listed below.

Respectfully submitted,  
HUNTON & WILLIAMS LLP

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By:

A handwritten signature in black ink, appearing to read "Robert A. King", is written over a horizontal line.

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